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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Optibase, Inc.**

Serial No. 75/**253,228**

Thomas I. Rozsa of **Rozsa & Chen** for **Optibase, Inc.**

David H. Stine, Trademark Examining Attorney, Law Office
114 (**Conrad Wong**, Acting Managing Attorney).

Before **Seeherman**, **Hanak** and **Rogers**, Administrative
Trademark Judges.

Opinion by **Rogers**, Administrative Trademark Judge:

Optibase, Inc. has filed an application to register
MPEG MOVIEMAKER, with MPEG disclaimed, as a trademark in
International Class 9 for goods identified as "computer
hardware and software for MPEG encoding of video and
audio."¹

The Trademark Examining Attorney refused registration
under Section 2(d) of the Trademark Act, 15 U.S.C.

§1052(d), on the ground that applicant's mark, if used in

connection with the identified goods, will be likely to cause confusion or mistake or to deceive consumers, in view of the prior registration of the mark MOVIE MAKER for "computer programs."²

When the refusal was made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, two key considerations are the similarities of the marks and the legally identical nature of some of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin with the goods and note that our analysis of the similarity or relatedness of the goods must be based on the identifications in the involved application and

¹ Serial No. 75/253,228, filed March 7, 1997, based on applicant's allegation of a bona fide intention to use the mark in commerce.

² Registration No. 1,348,959, issued July 16, 1985. Section 8 and 15 Affidavits accepted and acknowledged November 29, 1991.

registration. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Registrant's goods are broadly identified simply as "computer programs" without restriction as to type or use. Accordingly, we must consider the goods to include applicant's identified software, i.e., "software for MPEG encoding of video and audio." Moreover, in the absence of any restrictions on channels of trade or classes of consumers, we must presume that the respective goods move in all normal channels of trade and to all usual classes of consumers therefor. See CBS Inc. v. Morrow, 218 USPQ 198, 199 (Fed. Cir. 1983). In short, for our analysis, some of the goods are identical and their channels of trade and classes of consumers are presumptively the same. Indeed, applicant makes no arguments to the contrary.

Turning to the marks, applicant argues that the Examining Attorney has violated the "anti-dissection" rule and has failed to properly consider that MPEG is a part of applicant's mark, while it is not present in the mark in the cited registration.

We do not find the Examining Attorney to have acted improperly in according greater weight to the MOVIEMAKER element of applicant's mark. As noted herein, applicant has disclaimed rights in MPEG³; disclaimed or descriptive terms typically are given less weight when comparing marks. Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976). While we must consider the marks in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant also relies on a prior decision of this Board that held there is no absolute rule that an applicant cannot register a trademark which incorporates the entirety of a previously registered mark,⁴ and on a number of decisions wherein an applicant was able to register a mark

³ While the record does not reveal the significance of MPEG, we note the following:

MPEG \M'peg, M`P-E-G'\ n. **1.** Acronym for **M**oving **P**ictures **E**xperts **G**roup. A set of standards for audio and video compression established by the Joint ISO/IEC Technical Committee on Information Technology. ... **2.** A video/audio file in the MPEG format. Such files generally have the extension .mpg.
Microsoft Press Computer Dictionary 317 (3rd Ed. 1997).

⁴ In re Merchandising Motivation, Inc., 184 USPQ 364 (TTAB 1974).

which incorporated the entirety of a previously registered mark. We find all of those cases to be distinguishable, however, either because the appropriated term is descriptive in the resulting composite (e.g., "Menswear" merely descriptive of applicant's services in composite mark MMI MENSWEAR⁵) or the commercial impressions of the marks differ (e.g., TIC TAC v. TIC TAC TOE⁶).

In this case, the appropriated term is the arbitrary or suggestive word MOVIEMAKER⁷, and the additional element MPEG in applicant's mark does not change the commercial impression, which remains that of the term MOVIEMAKER. Applicant's adoption of MPEG as part of its mark would be viewed by consumers solely as a description of the type of computer software, namely, as indicating the particular type of encoding of video and audio that can be done with applicant's goods.

Finally, we note applicant's reliance on two cases wherein identical marks were registered by different

⁵ See *Merchandising Motivation*, *supra*.

⁶ See In re P. Ferrero & C. S.p.A., 178 USPQ 167 (CCPA 1973).

⁷ There is nothing in the record to indicate the nature of registrant's computer programs, so we cannot reach any conclusion regarding whether the registered mark is arbitrary or suggestive. In view of the more definitely identified goods of applicant, MOVIEMAKER is suggestive as part of applicant's mark.

parties for different goods.⁸ These cases, however, are not relevant, as applicant's goods and those in the cited registration are, in part, legally identical.

Under the circumstances of this case, we find that consumers familiar with registrant's mark used on its identified goods, if confronted with applicant's mark used on applicant's goods in the marketplace, will likely be confused as to source or sponsorship.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

E. W. Hanak

G. F. Rogers

Administrative Trademark
Judges, Trademark Trial
and Appeal Board

⁸ In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) (PLAYERS allowed to be registered by different parties for shoes and men's underwear because goods "distinctly different" and "not complementary or companion items"); and Faultless Starch Co. v. Sales Producers Associates, Inc., 530 F.2d 1400, 189 USPQ 141 (CCPA 1976) (court affirmed Board's decision that no likelihood of confusion existed despite use of FAULTLESS by different parties for canned foods and laundry starch).